

Serial No.: 10/766,409
Art Unit: 2687**REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed November 30, 2005. Through this response, claims 1 and 13 have been amended. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)**A. Rejection of Claims**

Claims 1-3, 5, 6, 8-14 and 17-20 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Giles et al.* ("*Giles*," U.S. Pat. No. 5,231,634) in view of *Katinakis et al.* ("*Katinakis*," U.S. Pat. No. 6,389,039). Claims 4, 7, 15 and 16 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Giles* in view of *Katinakis* and further in view of *Li* ("*Li*," U.S. Pat. No. 6,349,210). Applicant respectfully traverses these rejections.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

Independent Claims 1 and 13

In the present case, it is respectfully submitted that a *prima facie* case of obviousness has not been established. In particular, Applicant respectfully submits that a motivation to combine has not been established, among other deficiencies, and even assuming *arguendo* a motivation were to be present, the first message features of independent claims 1 and 13 have not been met. The Office Action asserts *Giles* as the primary reference, and the Office Action improperly attempts to equate the well-known RTS and CTS messages prevalent in legacy systems onto reservation messages (first message) used in a multi-channel system, as defined in independent claims 1 and 13. Clearly, *Giles* does not read on the first message features of independent claims 1 and 13 since, as admitted on page 3 of the Office Action, "*Giles et al.* does not clearly disclose a second shared-communications channel or transmitting over the combination of said first shared-communications channel and said second shared-communications channel." The Office Action asserts secondary reference *Katinakis* to allegedly remedy the deficiencies of *Giles*, and alleges "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify *Giles et al.* to include transmitting over the combination of said first shared-communication channel and said second shared-communication channel as taught by *Katinakis et al.* for the

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purpose of attaining higher bandwidth transmissions." Applicant respectfully disagrees, at least since the claimed features are still not shown.

Applicant also respectfully asserts that the disparity in such systems as *Giles* and *Katinakis* suggests an application of references in a manner consistent with improper hindsight reasoning. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). For instance, attaining higher bandwidth transmissions is simply too general a motivation to select *Giles*, a legacy system using RTS and CTS messages, in combination with *Katinakis*, a multiple channel system.

Additionally, Applicant believes that the proposed modification to meet the claim language would change the principle of operation of *Giles*. In other words, as indicated above, *Giles* appears to rely on well-known RTS and CTS messaging capabilities (see, for example, columns 3-4 of *Giles*). As Applicant has noted in the specification (see, for example, page 8 of Applicant's specification), the reservation messages (e.g., first message) are based on the RTS message except with modifications required. These modifications are neither disclosed nor suggested in the art of record.

Thus, since *Giles* in view of *Katinakis* fails to disclose, teach, or suggest the features of independent claims 1 and 13, and further have been improperly combined, Applicant respectfully requests that the rejection to independent claims 1 and 13 and their corresponding dependent claims be withdrawn and the claims allowed.

Dependent Claims 4, 7, 15, and 16

As explained above, Applicant respectfully submits that *Giles* in view of *Katinakis* fails to disclose, teach, or suggest the features of independent claims 1 and 13, and further

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submits that *Giles* and *Katinakis* have been improperly combined. The addition of *Li* does not remedy the aforementioned deficiencies. Accordingly, the combination of *Giles* and *Katinakis* is both improper and deficient of a motivation to combine, and thus Applicant respectfully requests that the rejection to claims 4, 7, 15, and 16 be withdrawn and the claims allowed.

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

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Art Unit: 2687**CONCLUSION**

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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